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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,992	12/05/2001	Ritsuko Tanaka	1086.1152	2820

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EXAMINER	
RETTA, YEHDEGA	
ART UNIT	**PAPER NUMBER**
3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/001,992	TANAKA ET AL.	
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed November 21, 2006. Applicant amended claims 1, 18, 19 and 21. Claims 1-25 are currently pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-19 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant amended claims 1, 18, 19 and 21 to recite registers a supplier providing a first non-privileged service with a first advertisement and users that have a contract with the supplier for the first non-privileged service. It is unclear what the non-privileged service with a first advertisement, and a second privileged service is. Examiner is interpreting the non-privileged service as a user needs to be register or pay or be a subscriber with the supplier to use the service and the service comes with an advertisement. Applicant also claims the advertisement preparation unit for preparing a second advertisement to be provided as a second privileged service. Since there is no first privileged service claimed, the advertisement is just a first privileged service. The first service is non-privileged. It is unclear what makes the service a non-privileged service or a privileged service. It is unclear what the first advertisement has to do with the non-privileged service. It is also unclear if applicant intended to claim that the first non-privileged service is provided to the users with a first advertisement (the service included the

first advertisement) or if the non-privileged service is the first advertisement itself. It is unclear what the first advertisement has to do with the non-privileged service and if there are two advertisement one non-privileged and one privileged. Examiner is unable to understand what applicant's claimed invention is.

To the extent the claimed invention was understood, the following art was applied.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-19 and 21 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite "*providing a first non-privileged service with a first advertisement* and users that have a contract with the supplier for the first non-privileged service and *a second advertisement to be provided as a second privileged service for user that have the contract* with the supplier for the first non-privileged service. Applicant's specification does not teach a privileged or non- privileged service. The specification teaches contractors that have subscription contract with newspaper dealer (first service) and advertisement requested by the advertiser (second service) and for placing on a web page so as to be viewed. Applicant's specification teaches the advertising service utilized the system for providing a first service (news paper) and a second service as an advertisement medium (see page 6 and 7). The specification also teaches,

the present invention the web pages on which advertisements are placed are only viewed by the contractor users who are registered in the database of the newspaper dealer ... (see page 7). As understood by the examiner the web site provides two services, publishing new and providing advertisement. The user who sees the publication also sees the advertisement.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, 15, 16 and 18-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Lapstun et al. (US 7,038,797).

Regarding claims 1, 3, 4 and 18, 19 and 21 Lapstun teaches a database, which registers a supplier (publisher) for providing a first ***non-privileged*** service (access to publication or site) and users (registered subscribers, see col. 23 lines 33-42) that have contracts with the supplier (publisher or the site) (see col. 23 lines 9-15, 49-67). Lapstun teaches different publishers providing publication by paying fee for the service which indicates that they are registered (see col. 25 lines 34-46) to provide service to subscribers (see col. 27 lines 6-12) and advertisement preparation unit for placing the advertisement on a web page (col. 27 line 55 to col. 28 lines 4, col. 29 lines 33-57); contractor users (subscribers) of the first service (publication) on the database allows the user to view the advertisements on the web page so as to provide a second

privileged service; wherein the second service is provided to the user at an independent time (different time from the advertiser entering the advertisement) and by a different medium (printed) for the first service.

Regarding claims 2, 20 and 22-25 Lapstun teaches a database, which registers a supplier (publisher) for providing a first service (access to publication or site) and users (registered subscribers, see col. 23 lines 33-42) that have contracts with the supplier (publisher or the site) (see col. 23 lines 9-15, 49-67). Lapstun teaches different publishers providing publication by paying fee for the service which indicates that they are registered (see col. 25 lines 34-46) to provide service to subscribers (see col. 27 lines 6-12) and advertisement preparation unit for placing the advertisement on a web page (col. 27 line 55 to col. 28 lines 4, col. 29 lines 33-57); contractor users (subscribers) of the first service (publication) on the database allows the user to view the advertisements on the web page so as to provide a second service; wherein the second service is provided to the user at an independent time (different time from the advertiser entering the advertisement) and by a different medium (printed) for the first service.

Regarding claims 5-13 and 15, Lapstun teaches giving a privilege offered by a newspaper dealer or an advertiser to user viewing the advertisement; making a link to the web page; making access to a web page of the advertiser managed by a newspaper dealer; stores advertisement selection information specified by a user and automatically edits a web page dedicated to the user and storing the resulting data; allowing the user to visit the page (see col. 25 line 3 to col. 26 line 11, col. 27 lines 20-26, col. 31 line 30 to col. 32 line 26).

Regarding claim 16, Lapstun teaches printing the advertisement placed on the web page on paper media and distributing the advertisement (col. 25 line 59 to col. 26 line 12, col. 27 lines 6-47).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. (US 7,038,797) further in view of Fredrickson Pub. No. US 2002/0019768 (hereinafter Fredrickson).

Regarding claim 17, Fredrickson teaches collecting registers visiting information of the user for each advertisement visit and determines and settles publication fee based upon the results of the survey (see 0050, 0065, 0066, 0067 and 0068-0086). It would have been obvious to one of ordinary skill in the art at the time of the invention to include such feature, in Lapstun, in order to charge advertisers based upon the visits, as taught in Fredrickson.

Claim 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. (US 7,038,797) further in view of Official Notice.

Regarding claim 14, Lapstun does not teach preparation of a guide map upon a request from the user. Official Notice is taken that is old and well known in the art of WWW to provide

a preparation of a guide map and to display it. On-line advertisers provide a program such as Mapquest to provide a map of a location, including the current location of the user and the destination specified by the user, in order to find the geographical location of the advertiser. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide such feature, in Lapstun web page, since Internet users use on-line map, such as Mapquest, to find the location of the advertiser providing the advertisement.

Response to Arguments

Applicant's arguments filed November 13, 2006 have been fully considered but they are not persuasive. Applicant argues all the independent claims together. However applicant only amended claims 1, 18, 19 and 21 to include the "***non-privileged service***". Claims 2, 20 and 22-25 do not include such limitation.

Applicant argues that Lapstun does not teach registering supplier providing a *first non-privileged service with a first advertisement* and users that have a contract with the supplier *for the first non-privileged service*". Applicant asserts that Lapstun discusses for each section, the reader optionally specifies it size, either qualitatively or numerically .... Thus, Lapstun discusses advertisement request by a user reader and therefore fails disclose ... a second advertisement, requested by advertiser to be provided as a second privilege service. Examiner respectively disagrees. Lapstun, personalized publication wherein the user selected builds a daily newspaper by selecting one or more news publications and creating a personalized version of each. Lapstun further discloses that the for each publication the reader (subscriber optionally selects specific sections and for each section the reader optionally specifies its size and the desired proportion of

advertisement. The advertisement is however is request by the advertiser to be provided as a on the publication. Lapstun teaches the personalization of the editorial content directly affects the advertising content, because the advertising is typically placed to exploit the editorial content. Further Lapstun discloses the value of the editorial content to an advertiser lies in its ability to attract large number of readers with the right demographics. Lapstun indicates that a news publisher' most profitable product is advertising "space" a multi-dimensional entity determined by the publication's geographic coverage, ... and the page area available for advertising... When the netpage publication server lays out each user's personalized publication, it picks the relevant advertisements from the netpage ad server (col. 23 line 49 to col. 26 lines 12);
Applicant also argues that the second privileged service is provided to the user at an independent time and by a different medium. Lapstun also teaches the advertisement is provided on on-line publication or printed and at independent time (daily publication) (see col. 23 lines 43-67, col. 27 lines 26).

Claims 2, 20, 22-25 are not being argued by applicant therefore the prior art is considered as an admitted prior art.

Examiner would like to point out to applicant that the claimed invention is so vague and applicant in his argument provided no clear understand of the claimed limitation in order to patentably distinguish the claimed invention from the prior art.

The rejection as being anticipated by Orikomio is withdrawn.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yehdega Retta

RETTA YEHDEGA
PRIMARY EXAMINER

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